

Appln No.: 09/394,454
Amendment dated July 25, 2005
In Response to Office Action dated March 24, 2005

REMARKS

Claims 69-71, 102, 108 and 116-117 are pending in this application. Claims 72, 73, 109, 110, 115 and 118-122 are canceled.

Applicants have canceled claims 72, 73, 109, 110, 115 and 118-122 without prejudice or waiver of applicants' right to file or obtain claims directed to any canceled subject matter in future divisional or continuing applications claiming priority from this application.

Applicants have amended claim 69 to specify that the morphogenic protein stimulatory factor is IGF-I and that the tissue is bone. Applicants have also amended claim 69 to improve its form.

Applicants have amended claims 108-110 and 116-117 to replace the term "morphogenic protein stimulatory factor" with the term "IGF-I" to parallel its antecedent basis.

None of the amendments introduces new matter.

Applicants now address the Examiner's March 24, 2005 Office Action below:

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Proposed Examiner's Amendment

The Examiner states that a proposed amendment was discussed with applicants' representative, as outlined in the March 18, 2005 Interview Summary attached to the March 24, 2005 Office Action. As stated in the Interview Summary, applicants agreed to the proposed Examiner's Amendment if the introduction of such amendments would place the application in condition for allowance.

The Examiner, however, states that he was unaware of double patenting issues that remain unresolved in the present application and that these issues must be resolved before the present application can be placed in condition for allowance.

Applicants have amended claims 69, 116 and 117 as per the Examiner's proposed amendments. Specifically, applicants have amended claim 69 to specify that the morphogenic protein stimulatory factor is IGF-I and to specify the induction of bone. Applicants have also amended claims 116 and 117 to replace the term "morphogenic protein stimulatory factor" with the term "IGF-I" to parallel its antecedent basis.

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Applicants will address the double patenting rejection below.

Double Patenting: Claims 69, 71, 102, 108-110 and 115-117

Claims 69, 71, 102, 108-110 and 115-117 stand rejected under the judicially-created doctrine of obviousness-type double patenting as unpatentable over claims 1-15 of United States Patent 6,048,964 ("the '964 patent") and claim 30 of United States Patent 5,948,428 ("the '428 patent").

First, applicants have rendered the rejection of claims 109, 110 and 115 moot by canceling those claims. Second, applicants submit herewith a terminal disclaimer, thereby obviating this obviousness-type double patenting rejection.

35 U.S.C. § 112, first paragraph

Claims 69, 71 102, 108-110 and 115-117 are rejected under 35 U.S.C. § 112, first paragraph because the Examiner states that, although the specification is enabling for a method of synergistically enhancing the ability of OP-1 to induce bone tissue, it does not reasonably provide enablement for a method of synergistically enhancing the ability of OP-1 to induce

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cartilage, tendon/ligament, and neural tissue. Applicants traverse.

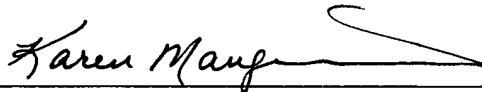
However, to expedite prosecution, applicants have amended the claims to cancel the recitation of cartilage, tendon/ligament and neural tissue. Applicants respectfully submit that they have clearly demonstrated that IGF-I synergistically stimulates OP-1 to induce bone formation. This is further confirmed by applicants and acknowledged by the Examiner in a post-filing publication by Yeh et al., "Osteogenic protein-1 and insulin-like growth factor I synergistically stimulate rat osteoblastic cell differentiation and proliferation," Endocrinology, 138: pp. 4181-4190 (1997), which clearly demonstrates that IGF-I synergistically stimulates OP-1's ability to induce bone nodule formation in FRC cells. Accordingly, applicants request that the Examiner withdraw this rejection.

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CONCLUSION

In view of the foregoing remarks and amendments, applicants request that the Examiner favorably reconsider this application and allow the claims pending herein. If the Examiner believes that a telephone conference would expedite allowance of this application, he is invited to telephone the undersigned at any time.

Respectfully submitted,



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